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03/03/98

MADEMANN

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EXAMINER

SOBUTKA, P

ART UNIT

PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 09/029,688
Filing Date: March 03, 1998
Appellant(s): MADEMANN, FRANK

Mark Bergner
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed April 17, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1,2,4-11,13, and 3,12, do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,953,667	Kauppi	9-1999
5,369,681	Boudreau et al	11-1994

5,588,043

Tiedemann, Jr. et al

12-1996

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4,6,10-13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kauppi (US 5,953,667) in view of Boudreau et al (US 5,369,681).

Consider claims 10,11,12. Kauppi teaches a location registration system in which mobiles transmit registration information that contains a cell identifier in addition to a location identifier (Kauppi see especially col 1, line 60 - col 2, line 48, col 4, lines 21-42), the cell identifier and location identifier being stored in a subscriber database of the MSC (Kauppi col 3, lines 33-48). Kauppi teaches that the cell identifier is used in the paging of the mobile to limit the signaling load by only paging in the identified cell (Kauppi see especially col 1, line 60 - col 2, line 48). Kauppi lacks a teaching of retaining the previous cell identifiers. Boudreau et al teaches a registration process that retains the previous cell identifiers in order to optimize the paging areas (Boudreau see especially col 9, lines 4-11). It would have been obvious to one of ordinary skill in the art to modify Kauppi to retain the previous cell identifiers in order to optimize the paging areas as taught by Boudreau.

As to claim 13, note that Kauppi's method includes paging to adjacent cells (Kauppi col 4, line 40 - col 5, line 25).

As to claims 1-4,6, the system of Kauppi in view of Boudreau would perform the claimed steps.

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Claims 5,7,8, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kauppi in view of Boudreau and in view of Tiedemann, Jr. et al (US 5,588,043).

As to claims 5,7,8, Kauppi in view of Boudreau lacks a teaching of storing the time of the last registration, along with the mobile, zone and cell identifiers. Tiedemann teaches storing the time of last registration in order to allow for the system to ensure minimum time between registrations (Tiedemann fig 1, item 50, col 1, line 54 - col 3, line 3, col 13, line 40 - col 14, line 65). It would have been obvious to one of ordinary skill in the art to modify Kauppi in view of Boudreau to also store registration time in order to allow the system to use the timer method of registration as taught by Tiedemann in order to ensure minimum time between registrations.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kauppi in view of Boudreau.

Kauppi lacks a teaching of the identifiers being sent according to a packet data service. It would be appreciated by those skilled in the art that the above difference would depend more upon engineering design considerations than on any inventive concept limitation because the overall operation of the system would not be changed by naming any particular data transfer service. Official Notice is taken that packet data service is notoriously well known in the art. It would have been obvious to one of ordinary skill in the art to modify Kauppi to use a packet data service to transfer the identifiers in order to utilize a resource efficient transfer method.

(11) Response to Argument

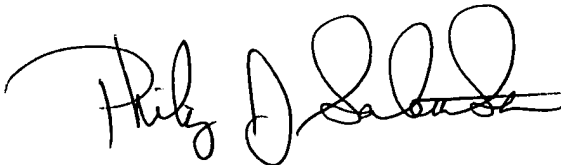
The appellant has argued that because the prior art teaches the use of statistical analysis to generate a paging list (see page 6, line 10 of the brief) that appellant's retained list distinguishes over the prior art. Appellant goes on to state that in the instant invention, the "list of cell identifiers is comprised of the cell identifier that was most recently transmitted by the mobile station, and retained cell identifiers that had been previously transmitted by the mobile station. When the mobile station does not respond to a paging directed to the last used radio cell then other prior earlier "last used" radio cells are used for the paging; it is only if paging these earlier cells do not evoke a response is the entire location area paged. " This argument does not distinguish over Beaudreau. To quote from Beaudreau's abstract: Beaudreau teaches "The system sends a page request to the location area where the desired mobile station last registered. If a response is not received, the system sends a page request to the paging area which includes a plurality of location areas where the mobile station is likely to be found. If a page response is still not received from the desired mobile station, then a page request will be sent to all of the location areas within the service area." Note also Beaudreau's comments at column 9, lines 1-19, column 9, line 65 – column 10, line 13). It is not understood how Beaudreau's statistical generation of a list would be distinguished over by the claim which merely recites " a list of cell identifiers comprising both the transmitted cell identifier and retained cell identifiers which were formerly transmitted cell identifiers" (claim 1) clearly Beaudreau's list of cell identifiers, even

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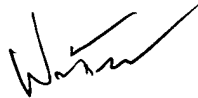
though assembled using statistical analysis, would still be constructed of "retained transmitted cell identifiers" see Beaudreau at column 10, lines 14-29. Note also that the claims are not limited as to where the identifiers or list are stored in the system. As to claims 3 and 12, it is believed that appellant's arguments have been answered in the passages of Beaudreau cited above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Philip Sobutka



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June 26, 2001

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